

**REMARKS**

This communication responds to the Office Action mailed December 15, 2008, the period for response to which has been extended to June 15, 2009.

**Restriction Requirement**

In the Office Action the Examiner required that Applicant be restricted to one inventions. Applicant confirms that a provisional election was made to prosecute the invention of Group I, claims 1-9, 19, 20 and 22-24. The withdrawn claims have been canceled by the amendment above.

**Rejection under 35 USC § 102**

The Examiner has rejected claims 1-4, 19, 20 and 22-24 as being anticipated by Parks et al., U.S. Patent No. 7,025,790 ("Parks").

Applicant traverses the anticipation rejection on the grounds that Parks does not disclose each element of the pending claims. Parks discusses an ankle joint prosthesis and its method of implantation. In stark contrast to Applicant's claimed invention, Parks discloses only total ankle prosthetics. As background, a total ankle prosthesis is a multiple piece joint prosthesis whereby each bone making up the joint has a piece fixed to it. Accordingly, as the joint is articulated, the various parts of the prosthesis articulate against each other and bone does not articulate against the prosthesis. A disadvantage of a total joint prosthesis is that attaching the various parts of the prosthesis to the bone is an invasive surgical procedure that requires much bone to be removed. This is shown in Parks, for example in Figure 4, which shows in dotted lines the portion of the

bone that must be removed from both the tibia and the talus before the prostheses can be implanted.

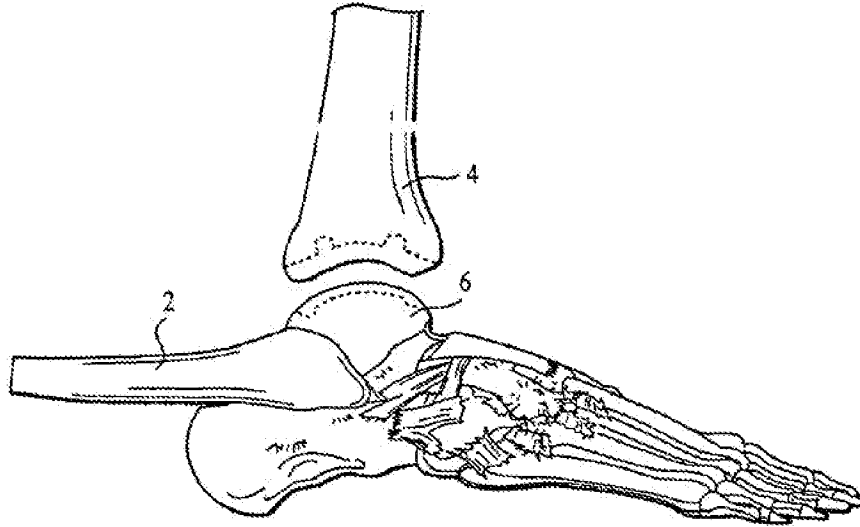


FIG. 4

The prostheses described in Parks all require at least a talar component attached to the talus, and a tibial component attached to the tibia. *See Parks Col. 9, line 37-Col. 10, line 24, and Col. 11, line 3- Col. 12, line 3.* Depending on the embodiment, a mobile bearing component or a semi-constrained bearing component is located between the talus component and the tibial component. Accordingly, Parks discloses only total ankle prosthetics.

In contrast, Applicant claims an interpositional tibiotalar implant. Such an implant has a first major surface that is adapted to be positioned against a tibia and a second major surface adapted to be positioned against a talus. As clarified by the amendment to claim 1 above, the tibia is allowed to articulate across the first major surface. Such an implant does not require the major bone resection required by total ankle prosthetics and is therefore more easily implanted. Parks does not disclose such an implant because, as described above, it requires a component to be fixed to both the tibia and the talus, which does not allow the tibia to articulate across any of

the prosthetics surfaces. Accordingly, the lack of novelty rejection of claim 1, and the claims depending therefrom, should be withdrawn.

Further, with respect to independent claim 22, this claim includes that the implanted device is substantially free of anchoring portions that need to be attached to the bone, cartilage, ligaments or other tissue, yet by its design is capable of being used with minimal translation, rotation, or other undesired movement or dislocation within or from the joint space. Such an implant is clearly not shown in Parks, which describes aligning and matching the protrusions and shoulders of the various components with the matching recesses or groves that have been prepared in the tibia and talar surfaces, as shown in Figure 21 reproduced below. *See Parks, col. 12, lines 8-20.* Hence, the rejection of claim 22 should be withdrawn.

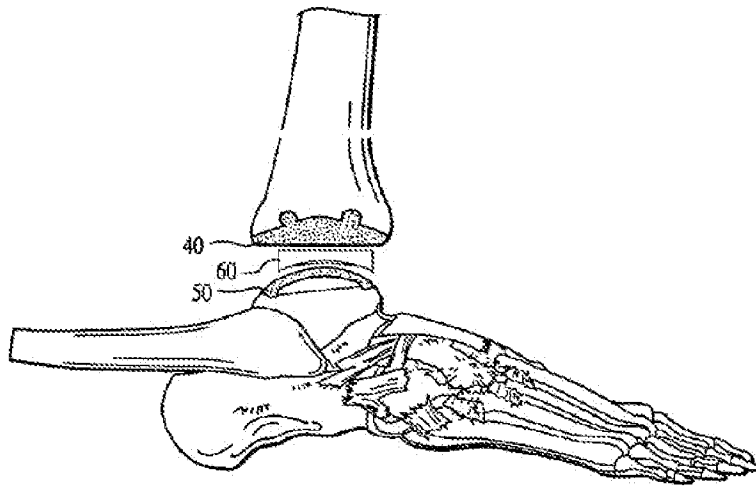


FIG. 21

With respect to new independent claim 25, it further includes that the implant comprises an integral bead shaped structure proximate its anterior side adapted to cap and thereby engage the neck of the talus to improve fixation to the talus. No such structure is disclosed in Parks. At its closest, Parks discusses protrusions or ridges 58 that extend from the bottom surface of the talus components. However, as described above, these features are meant to be aligned with and

placed in recesses that have been formed into the talus surface. Accordingly, they do not engage the neck of the talus as presently claimed. Hence, new claim 25 is allowable over the cited references.

**Rejection under 35 USC § 103**

The Examiner has rejected claims 5-9 as being unpatentable over Parks et al., U.S. Patent No. 7,025,790, in view of Schon U.S. Patent No. 6,572,620. This rejection is traversed for the reasons provided above, and for others as well. Schon discloses an elongated blade 20 to fix ankle bone relative to the tibia. Accordingly, Schon is a joint fixation device, not an interpositional implant that allows the joint to articulate after implantation. Hence, Schon adds nothing to remedy the defects of Parks et al. in this regard, and the obviousness rejections of these claims should be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Commissioner is hereby authorized to charge any additional fees required to Deposit Account No. 061910.

Respectfully submitted,

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